

REMARKS

Applicant regrets that the Examiner was unable to grant the Applicant's repeated requests for a telephonic interview because of the unavailability of the file. Applicant believes that the issues could have been dealt with far more efficiently in a discussion than the formal response below.

The Examiner has rejected claims 26-30 under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US 6,405,033) in view of Brilla (US 6,389,276). Applicant respectfully traverses the Examiner's rejection because the Examiner has not established a Prima Facie Case of Obviousness. A Prima Facie Case of Obviousness has not been established for a variety of reasons as detailed below.

With regard to Prima Facie Case Obviousness MPEP 2142 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally (Third), the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding the requirement of a Prima Facie Case of Obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations, claim limitations are individually discussed below:

Claim 26 First Element "accepting an incoming call"

The Examiner states that the first element of claim 26 "accepting an incoming call" is met by figure 1 item 12 of Kennedy. Figure 1 item 12 of Kennedy depicts a truck having a mobile unit. There is no indication that the mobile unit accepts an incoming call.

In the passage cited by the examiner, i.e. Kennedy Column 3 lines 54-67 Kennedy states the mobile unit is used for initiating a call:

“FIG. 1 illustrates a communication system 10 that includes a number of mobile units 12 coupled to a network switching center (NSC) 14 and a number of service centers 16 by a voice network 18 and, optionally, a data network 20. Each mobile unit 12 includes at least a user interface 22 and a platform 24. In one operation, interface 22 and platform 24 enable control of the local features and functions available at mobile unit 12. In another operation, interface 22 and platform 24 enable mobile unit 12 to issue a request for enhanced services from service centers 16 using NSC 14. NSC 14 accesses stored profile tables using a service message issued by mobile unit 12 to select an appropriate service center 16. The selected service center 16 provides enhanced services to mobile unit 12 to satisfy the request.”

Applicant requests that the examiner point out exactly where in this passage or anywhere in Kennedy a mobile unit accepts a call.

Claim 26 Second Element “displaying the source of the call”

The Examiner states that the second element of claim 26 “displaying the source of the call” is met by element 22 of Fig. 1. Element 22 of Fig. 1 is labeled “user interface”.

The Examiner also cites column 2 lines 41-53, column 3 lines 54-67 and column 4 lines 12-22. These passages are repeated below:

“Further technical advantages of the present invention include a user interface at the mobile unit having a display and a number of buttons. In one embodiment, the display presents a menu structure having one or more levels of static or dynamic menu options that facilitate requesting enhanced services from the service centers, monitoring and controlling sensors and actuators at the mobile unit, and performing any of the unique features and functions of the mobile unit. The service centers may also download to the mobile unit menu data specifying new or updated menu structures and/or associated menu options for available enhanced services. The operator of the mobile unit may navigate through and select menu options using the buttons.” Kennedy column 2 lines 41-53

In this passage Kennedy does not indicate anywhere that there is an identification of the source of the call. Quite to the contrary Kennedy indicates “the display presents a menu structure having one or more levels of static or dynamic menu options that facilitate requesting enhanced services from the service centers” thereby identifying the mobile as the source of the call. There is no need to identify the source of a call because the mobile initiates Kennedy’s calls.

In the next passage cited by the Examiner is column 3 lines 54-67 of Kennedy:

“FIG. 1 illustrates a communication system 10 that includes a number of mobile units 12 coupled to a network switching center (NSC) 14 and a number of service centers 16 by a voice network 18 and, optionally, a data network 20. Each mobile unit 12 includes at least a user interface 22 and a platform 24. In one operation, interface 22 and platform 24 enable control of the local features and functions available at mobile unit 12. In another operation, interface 22 and platform 24 enable mobile unit 12 to issue a request for enhanced services from service centers 16 using NSC 14. NSC 14 accesses stored profile tables using a service message issued by mobile unit 12 to select an appropriate service center 16. The selected service center 16 provides enhanced services to mobile unit 12 to satisfy the request.” Kennedy column 3 lines 54-67.

Again there is no need to identify the source of a call because the mobile initiates the call.

The final passage cited by the Examiner with respect to the second element is column 4 lines 12-22 of Kennedy:

“User interface 22 includes a display 34 and a variety of buttons 36. Interface 22 enables local access to platform 24, sensors 26, actuators 28, and computing devices 30, and/or remote access to service centers 16 via NSC 14 using network 18 and, optionally, network 20. An operator of mobile unit 12 may activate a button 36 to perform any contemplated feature or function of user interface 22 and/or mobile unit 12, such as, for example, to request a desired service from a particular service center 16, or to monitor and control sensors 26, actuators 28, and/or computing devices 30.” Kennedy column 4 lines 12-22.

Again the user interface is described as an input device "Interface 22 enables local access to platform 24, sensors 26, actuators 28, and computing devices 30, and/or remote access to service centers." There is simply no identification by the mobile as the source of the call since the mobile is the source of the call.

Applicant requests that the examiner point out exactly where in these 3 cited passages or anywhere in Kennedy displaying the source of the call is indicated. Kennedy, as clearly stated in the Abstract "Using a user interface, an operator of a mobile unit issues a request for services from one or more service centers." Obviously the mobile unit is issuing requests, and is the source of the call.

Claim 26 Fourth Claim Element "responding to the first input by providing a prerecorded message in response to the incoming call"

The Examiner cites column 4, line 55 - column 5, line 47; column 6, lines 34-55; column 9, lines 49-65; column 26, lines 35-65; and column 29, lines 43-60. Applicant will not repeat all the quoted passages, suffice it to say that in Kennedy there is no mention of a "responding to the first input by providing a prerecorded message in response to the incoming call". Kennedy describes messages that are generated, speech synthesis, and a variety of other mechanisms but there is no response generated to an incoming call in response to a first input. Applicant has reviewed the many cited passages multiple times but fails to see the claimed element in any of them. Applicant requests that the examiner specifically point out where this element is.

Claim 26 Fifth Claim Element "accepting a second input to terminate the prerecorded message and answer the call"

To meet this fifth claim element the Examiner cites Brilla, et al.

The Examiner states "Since the wireless network 120 has the capability to transmit command to the digital telephone 122, and it also includes a short message service server, 130 it is considered that the digital telephone 122 can be placed automatically in a call delay

answering mode when it receives the command from the system.” The Applicant respectfully reminds the Examiner that saying that “the digital telephone 122 can be placed automatically in a call delay answering mode” does not establish a Prima Facie Case of Obviousness. MPEP 2143.01 states, in bold, that the **“FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS”**

No where in Brilla is there a hint of suggestion of terminating a prerecorded message and answering a call. Brilla is “A system for remote notification of new voicemail messages stored in a landline based voicemail system to a wireless mobile telephone.” Brilla abstract

The short message server 130 cited by the examiner provides a test message indicating that a voice mail was received at the customer premises 108. Applicant fails to see the pertinence, and in fact Applicant is unable to understand the Examiner’s arguments with respect to Brilla. Simply put Applicant finds no place in Brilla where any message is terminated in response to an input, which is the gist of claim element 5. Applicant specifically asks that examiner specifically point out anywhere in Brilla where any prerecorded message is terminated in response to an input. This fifth claim element is not found in any of the passages cited by the Examiner or anywhere else in the patent that the Applicant can find.

Since the Examiner has not identified anywhere where 1,2,4 and 5 are present in the prior art, and MPEP 2142 requires “the prior art reference (or references when combined) must teach or suggest all the claim limitations” the Examiner has not established a Prima Facie Case of Obviousness.

Even if such an element were found in Brilla, it could not be combined with Kennedy to result in Applicants claim for several reasons as discussed below.

MPEP 2143.01 states that **“THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPAL OF OPERATION OF A REFERENCE”** If the proposed modification or combination of the prior art would change the principle of operation of the prior art

invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner has cited Brilla with respect to Claim 26 Fifth Claim Element “accepting a second input to terminate the prerecorded message and answer the call” In column 6 lines 16 – 32 Brilla states:

“Hence, the present invention provides an arrangement where a voicemail subscriber on a telephone network, such as a public switched telephone network or a corporate network having a private branch exchange, may be remotely notified of new messages stored in his or voice mail box by the transmission of a notification message to a wireless telephone network in communication with a mobile telephone unit used by the voicemail subscriber.”

Applicant’s disclosure prevents new messages from being stored. Applicant’s claim element clearly states that an input is accepted to answer the call. If the call is answered no voicemail messages are stored.

The final element of claim 6 is “accepting an input to terminate the prerecorded message and answer the call.” Answering the call prevents the need for storing a message at all. If Brilla is modified so that messages are not stored then there is no need for notification of stored messages. The title of Brilla is SYSTEM AND METHOD FOR PROVIDING VOICE MAIL NOTIFICATION ... Applicant’s system of call answering pre-empts voice mail, and hence the purpose of Brilla’s System, the handling of voice mail notification, would be destroyed by any such modification which pre empts the need for voice mail.

Additionally providing a system for voice mail notification of stored, i.e. already received, messages teaches directly away from the Applicant’s disclosure which prevents messages from being stored. The sixth element of claim 26 “accepting an input to terminate the prerecorded message and answer the call.” prevents messages from being stored by allowing the call to be answered. MPEP 2141.02 says that prior art must be considered in its entirety including disclosures that teach away from the claims. Brilla teaches away by teaching the handling of voice mail, which applicant’s method removes the necessity for, and hence Brilla cannot be used to support a *prima facie* case of obviousness.

Additionally MPEP 2146 states References Cannot Be Combined Where Reference Teaches Away from Their Combination. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). It is obvious on its face that Kennedy cannot be combined with Brilla. Kennedy's A SYSTEM AND METHOD FOR ROUTING A CALL USING A COMMUNICATIONS NETWORK is incompatible with Brilla's SYSTEMS AND METHODS FOR PROVIDING VOICE MAIL NOTIFICATION FROM A SEPARATE VOICE MAIL SYSTEM TO MOBILE TELEPHONE. Kennedy routes calls Brilla provides notification of stored calls. If calls are routed to a destination they are not stored for notification of the destination. Brilla and Kennedy at their simplest are different ways of handling calls, which are not compatible. Storing a call precludes routing a call and visa versa. Hence the combination of Kennedy and Brilla cannot be used to support a *prima facie* case of obviousness.

In summary the Examiner has not not established a Prima Facie Case of Obviousness for claim 26 because:

1. 4 of 5 claim elements are not found in the prior art cited,
2. the proposed combination would change the operation of Brilla
3. the references not only teach away from their combination they are incompatible with each other and accordingly there can be no expectation of success or motivation to combine
4. Examiners argument that the "digital telephone 122 can be placed automatically in a call delay answering mode" is an argument that such capability is within the skill of one skilled in the art is not sufficient to support a Prima Facie Case of Obviousness.

Because the Examiner has not established any of the three elements sufficient to support a Prima Facie Case of Obviousness, Applicant respectfully asks that the Examiner either withdraw the unsupported rejection, or provide proper support for a Prima Facie Case of Obviousness.

In light of the foregoing, the Examiner's reconsideration of this application with a view toward allowance is respectfully requested. The Examiner is invited to call the undersigned agent if a telephone call could help solve any remaining items.

Respectfully submitted,

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